

Application No. 10/769,813
Amendment dated February 5, 2009
After Final Office Action of December 1, 2008

Docket No.: 1630-0455PUS1

REMARKS

Claims 1-11 and 14-17 are pending in the present application. Claims 1, 7, 12 and 13 are independent.

Rejections Under 35 U.S.C. § 102

Claims 14 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2004/0218497 to Choi et al. ("Choi"). Claims 14 and 15 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent Application Publication 2004/0130991 to Tawaragi. These rejections are respectfully traversed.

The effective date of Choi under 35 USC §102(e) is its U.S. filing date of December 5, 2003, which is subsequent to Applicant's effective filing date under 35 USC §119 of February 4, 2003.

The effective filing date of Tawaragi under 35 USC §102(e) is its U.S. filing date of July 23, 2003, which is subsequent to Applicant's effective filing date under 35 USC §119 of February 4, 2003.

The Examiner has already acknowledged receipt of a certified copy of Applicant's priority Application, Republic of Korea 10-2003-0006937, filed on February 4, 2003. In order to perfect benefit of that priority Application, Applicant is filing, as attachments to this Reply, an English language translation of that priority Application and a declaration that the translation is accurate. Full support for the claimed invention is found in the attached English language translation of Applicant's priority application.

Accordingly, Applicant respectfully submits that Choi and Tawaragi have been removed as prior art with respect to this Application.

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Reconsideration and withdrawal of these rejections under 35 USC §102(e) of claims 14 and 15 are respectfully requested.

Rejection under 35 USC §103(a)

Claims 14 and 15 stand rejected under 35 USC §103(a) as being unpatentable over U.S. patent 6,859,425 to Maegawa et al. ("Maegawa"). This rejection is respectfully traversed.

Claim 14 recites a method for determining the type of an optical disk that is loaded into an optical disk device, comprising loading the optical disk into the optical disk device; determining initially a type of the loaded optical disk; activating a focusing servo based on the initial determination result; detecting a level of a wobble extraction signal while the focusing servo is activated and a tracking servo is turned off; determining finally the type of the loaded optical disk based on the detected wobble extraction signal level; and performing a tracking servo adjustment operation according to the finally determined type of the loaded optical disk.

Claim 15 recites an apparatus for determining the type of an optical disk loaded into an optical disk device, comprising means for loading the optical disk into the optical disk device; means for determining initially a type of the loaded optical disk; means for activating a focusing servo based on the initial determination; means for detecting a level of a wobble extraction signal while the focusing servo is activated and a tracking servo is turned off; means for determining finally the type of the loaded optical disk based on the detected wobble extraction signal level; and means for performing a tracking servo adjustment operation according to the finally determined type of the optical disk.

The Office Action states that Maegawa determines the type of the loaded optical disk based on the detected wobble extraction signal, indicating that disclosure of this feature is

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found in col. 32, lines 5-40.

Applicant strenuously disagrees with this conclusion because nowhere in Maegawa is there any explicit or inherent (which requires not just a possible disclosure, and not just a probable disclosure, but a necessary disclosure) teaching of determining the type of loaded disk based on the detected wobble signal. Inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In col. 32, lines 5-40, Maegawa discloses details of its wobble detection circuit and states that it may be applied to a plurality of types of recording media. Maegawa is directed to extracting a wobble signal with high accuracy regardless of the difference characteristics between different types of optical recording media including differences in laser light power for forming the optical recording media space region and for forming the optical recording media mark region (col. 5, line 51 to col. 5, line 35). However, there is no disclosure whatsoever in Maegawa of using the wobble signal to determine what type of media is being loaded into the optical disk device.

The Office Action then admits that Maegawa does not specifically show the step of performing a tracking servo adjustment operation according to the finally determined type of loaded disk, and concludes that "[H]owever, the optical disk detecting system of Tawaragi capable of detecting between CD-ROM, DVD-ROM, CD-R/RW or DVD-R/RW in order to perform recording of reproducing operations on this type, obviously, the tracking servo must be adjusted depend on the type of the optical recording medium as claimed."

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Clarification is required as to the basis of this rejection. It is not clear whether it is on MAEGAWA alone or TAWARAGI alone or some combination of both of these cited references.

Not only is the basis of the rejection in terms of what reference(s) is/are being relied on, but the Office Action is taking official notice of the tracking servo feature. This is improper for a number of reasons.

In this regard, Applicant notes the decision in *In re Boon*, 169 USPQ 231 (CCPA 1971), which points out that the Office must provide a specific reference in support of the grounds used to reject a claim and, in this regard, states that the Office may not judicially notice factual grounds for a rejection unless those facts are supported by a standard reference work and play a minor role, i.e., serving only to fill in gaps in the Office's evidentiary showing in support of a particular ground for rejection.

No reference has been provided to support the Examiner's conclusion, and this conclusion is a major part of the rejection, not a minor role part of the rejection.

Thus, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 14 and 15.

Accordingly, reconsideration and withdrawal of this rejection of claims 14 and 15 are respectfully requested.

Allowed Claims

Applicant acknowledges with appreciation the allowance of claims 1-11, 16 and 17.

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Conclusion

In view of the above remarks, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Rober J. Webster, Reg. No. 46,472 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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Attachments: English Language Translation of Republic of Korea 10-2003-0006937
Declaration of Accuracy of Translation